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ROB PHILLIPS
15 HASSAYAMPA TRAIL
HENDERSON, NV 89052

EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,781

Applicant(s)

RAYMENT, BARRY D.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-12 have been examined.

Response to Amendment

2. The Amendment filed on 7/18/06 is sufficient to overcome the prior rejection. The prior 35 USC 102 rejection has been changed into a 35 USC 103 rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (6,415,262).

Claim 1: Walker discloses a method for increasing business revenue including:

a first customer visit;

payment for services and/or goods received during the first visit;

payment of an additional sum of money;

a second customer visit; a refund of the additional sum;

and a predetermined discount for services or goods received during the second customer visit

(Fig. 5 thru Fig. 18; and below citations):

“(2) In accordance with the present invention, there are provided new and improved systems and methods that enable a business to provide a customer with a subscription to a product in order to encourage the customer to participate

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in transactions on a regular, frequent basis (e.g. once per week). The subscription provides the customer with a discounted price on the product defined by the subscription. The subscription also defines conditions that the customer has to meet in order to remain entitled to the discounted price. The conditions may include a subscription frequency and a subscription duration. The subscription frequency defines the length of time between required product purchases of the subscription. The subscription duration is the time during which the conditions defined by the subscription are imposed on the customer and during which the customer is provided with the subscription price for the product of the subscription. In some embodiments of the present invention, the customer may be penalized for failing to fulfill the conditions of the subscriptions. The penalty may be a charge of a monetary amount (col 3, lines 45-65).

(31) Referring to FIG. 12, a table 1200 represents an embodiment of the available subscriptions database 534 (FIG. 5). The table 1200 includes entries 1202, 1204, 1206, 1208, and 1210, each defining an available subscription. It will be understood by those skilled in the art that the table 1200 may include any number of entries. The table 1200 also defines fields for each of the entries 1202, 1204, 1206, 1208 and 1210 which specify (i) a unique subscription identifier 1220, (ii) a deposit 1222 required to initiate the subscription, and (iii) a penalty 1224 imposed on a customer that does not successfully complete the subscription. A subscription identifier 1220 comprises a combination of a frequency identifier 820 (FIG. 8), a duration

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identifier 920 (FIG. 9) and a product identifier 620 (FIG. 6). Successfully completing a subscription comprises satisfying all of the conditions of the subscription during the duration of the subscription. The penalty defined by each subscription is the action to be taken if the customer does not successfully complete a subscription he is subscribed to. For example, entry 1202 indicates that the penalty associated with subscription "A3M-P1" consists of a retention of the deposit the customer had paid upon initiating the subscription (col 10, lines 15-37).

(47) If it is determined that the customer has indicated an acceptance of the offer (step 1535), the subscription is initiated (step 1540). Initiating a subscription may comprise storing (i) the subscription identifier of the offered subscription, (ii) the start time of the subscription, and/or (iii) the end time of the subscription, which may be based on the duration of the subscription (i.e. if the subscription duration is six months and the start time of the subscription is Jan. 1, 1999, the end time of the subscription is Jul. 1, 1999). The start time of the subscription may comprise (i) the time of acceptance of the subscription offer, (ii) the time of the first usage of the subscription price by the customer, or (iii) another time determined by the business. If the customer is currently purchasing a product to which he accepts a subscription, the subscription price may be applied to the current transaction or to the next purchase of the product by the customer. The step 1545 of initiating a subscription may further comprise charging any deposit

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associated with the subscription to the purchase total of the customer's current transaction (col 14, lines 45-65).

(65) In the embodiment where the customer had previously paid a deposit upon initiating a subscription, that deposit may be automatically applied to the renewed subscription upon the customer's acceptance of the renewal offer. Additionally, a monetary amount may be paid out to the customer upon the customer's acceptance of the offer. The monetary amount may be in the form of (i) a coupon for the monetary amount, usable for purchases at the business; (ii) a cash payment; (iii) a credit to a financial account associated with the customer; (iv) an increase of the deposit previously paid for by the customer; or (v) any combination thereof. Such a monetary amount may be paid out to the customer upon each renewal of the subscription (col 19, lines 34-46).

(66) If, in step 1820, the customer's response did not indicate an acceptance of the renewal offer, the customer's successfully completed subscription is terminated (step 1830). Terminating a successfully completed subscription may include setting the status of the subscription in the customer's record of the customer database 538 (FIG. 5) to "fulfilled." Terminating the subscription may also include returning to the customer any deposit he may have paid at the time of initiating or accepting the subscription. Returning the deposit may comprise, for example (i) paying a monetary amount to the customer that is not less than the amount of the deposit, or (ii) applying a discount or credit to a current purchase of the customer, wherein the discount or credited amount is

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not less than the deposit amount (col 19, lines 45-60).

[Claim] 49. The method of claim 48, wherein the first subscription has an associated first deposit that was paid by the customer at a time of initiating the first subscription, and wherein the offer for the second subscription includes a second deposit required to initiate the second subscription”.

Examiner notes that Walker’s deposit which is added onto the price of purchase of goods or service and allows the customer to receive discounts on future visits where the deposit can also be returned to the customer for cash is equivalent to the Applicant’s payment as described in the Applicant’s claim 1.

Additionally, Walker does not explicitly disclose that the deposit can be returned and the discount applied at the same time.

However, Walker discloses applying a discount to purchases after the user/customer has paid an additional sum of money/deposit (Abstract; col 2, lines 45-55).

Walker discloses returning the deposit to the customer after the user has made a purchase(s), “returning to the customer any deposit he may have paid at the time of initiating or accepting the subscription” (col 19, lines 45-60).

And, Walker discloses both returning the deposit amount to the customer and applying a discount to a current purchase:

“Returning the deposit may comprise, for example (i) paying a monetary amount to the customer that is not less than the amount of the deposit, or (ii) applying a discount or credit to a current purchase of the customer, wherein the discount or credited amount is not less than the deposit amount (col 19, lines 45-60).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Walker can return a deposit and apply a discount at the same time. One would have been motivated to do this in order to provide further flexibility as to rewarding the user.

Also, note in Walker that the frequency of period can be anywhere from one to two to numerous shopping trips and/or a wide range of time periods (col 2, lines 47-55). And, the Applicant's claims state one shopping trip and a subsequent shopping trip. Hence, the Applicant's 2 shopping trips is within the range of Walker's 1 to many shopping trips. Also, see MPEP 2144.05.I for why this is obvious.

Claim 2: Walker discloses the method as defined in claim 1 wherein the customer receives proof of payment of the additional sum of money and presents said proof during the second visit (col 19, lines 34-60; col 4, line 65-col 5, line 20).

Claim 3: Walker discloses the method as defined in claim 1 wherein a computer processor tracks customer information of the customers participating in the method (col 1, lines 45-60).

Claim 4: Walker discloses the method as defined in claim 1 wherein the business is a restaurant (col 2, lines 12-20; col 4, lines 1-10).

Claim 5: Walker discloses the method as defined in claim 1 wherein the predetermined discount is based on the amount of the payment for services or goods received during the first visit (Fig. 6).

Claim 6: Walker discloses the method as defined in claim 1.

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Walker does not explicitly disclose that the additional sum of money is predetermined in the range of \$5.00 to \$25.00.

However, Walker discloses a range of additional sums of money (Fig. 12, 'Deposit').

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Walker's deposit can be in a range of monetary amounts. One would have been motivated to do this in order to provide appropriate or optimal deposit amounts.

Also, MPEP discloses that a change in size/proportion or an overlap of ranges is obvious (2144.04.VI.A and 2144.05.I). Hence, a flexible deposit amount for grocery store purchases can obviously be in the range of \$5 to \$25.

Claim 7: Walker discloses the method as defined in claim 1 wherein the additional sum of money is based on the amount of the payment for services or goods received during the first visit (Fig. 6).

Claims 8, 12: The method as defined in claim 1 wherein the business retains the additional sum of money when no second customer visit occurs within a pre-defined time limit (col 10, lines 15-37; col 14, lines 45-65).

Claim 9: Walker discloses the method as defined in claim 1 wherein the additional sum of money is paid during each subsequent visit permitting the customer to receive predetermined discounts on each subsequent visit ([Claim] 49; Fig. 5; col 10, lines 15-37; col 14, lines 45-65). Also, note in Walker that the expiration date can be set such that the customer will have to repay a deposit for each subsequent discount/subscription.

Claim 10: Walker discloses the method as defined in claim 9 wherein the predetermined discount increases with the payment of each subsequent additional sum of money:

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“(ii) applying a discount or credit to a current purchase of the customer, wherein the discount or credited amount is not less than the deposit amount (col 19, lines 45-60).

[Claim] 50. The method of claim 49, wherein the second deposit is greater than the first deposit.”

Notice in Walker that the deposit amount increases and that the discount is not less than the deposit amount. Therefore, the discounts amount also increases.

Claim 11: Walker discloses the method as defined in claim 9. Walker does not explicitly disclose wherein the additional sum of money paid decreases during each customer visit. However, Walker discloses increasing the deposit amount (Claim 50).

Also, Walker discloses that in subsequent deposit amounts that the deposit can be reapplied, that the deposit amount can be increased without further cost to the user, that the same deposit amount can be charged but that a cash amount can be given to the user at the same time:

“(65) In the embodiment where the customer had previously paid a deposit upon initiating a subscription, that deposit may be automatically applied to the renewed subscription upon the customer's acceptance of the renewal offer.

Additionally, a monetary amount may be paid out to the customer upon the customer' acceptance of the offer. The monetary amount may be in the form of

(i) a coupon for the monetary amount, usable for purchases at the business;
(ii) a cash payment; (iii) a credit to a financial account associated with the customer; (iv) an increase of the deposit previously paid for by the customer;
or (v) any combination thereof. Such a monetary amount may be paid out to the customer upon each renewal of the subscription” (col 19, lines 33-46).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that since Walker can adjust the deposit amount over time or visits that Walker can also decrease the deposit amount. One would have been motivated to do this in order to optimal deposit amounts or deposit amounts that are of interest to the user.

Also, Examiner notes that a reversal of direction is obvious (MPEP 2144.04.VI.A). Hence, is obvious that if the deposit amount can be increased that it can also be decreased.

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the grounds of rejection above. Please particularly note section added in the rejection of the independent claims above that begins with, "Additionally, Walker does not explicitly disclose that the deposit can be returned and the discount applied at the same time". Also, new citations/explanations have been added to the rejection of dependent claims 6 and 11 above. Also, please note the comments below.

On page 4 of the Applicant's Remarks dated 7/18/06, Applicant states that, 'nothing in Walker require . . . the customer to return to a business'.

However, the title of Walker is oriented to a user coming to a retail business, "Method and apparatus for determining a subscription to a product in a retail environment".

And, the title of the incorporated by reference Walker application 09/049,297 is also so oriented, "SYSTEM AND METHOD FOR TRACKING AND ESTABLISHING A PROGRESSIVE DISCOUNT BASED UPON A CUSTOMER'S VISITS TO A RETAIL ESTABLISHMENT".

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And the Specification of Walker (6,415,262) states:

“The conditions of the subscription are selected so as to maximize the customer's visits to the business offering the subscription without unnecessarily eroding the profits of the business.

(Abstract)

FIELD OF THE INVENTION

(2) The present invention relates to point-of-sale systems, and more specifically to methods and systems for determining and applying discounts by using point-of-sale systems.

(3) BACKGROUND OF THE INVENTION

(4) In most areas of business, several entities compete for the same set of potential customers. Consequently, each business must aggressively pursue marketing strategies to attract customers and induce customer loyalty to their particular establishment. For example, the grocery store industry is highly competitive. There are approximately seventy-five large supermarket chains in the United States. In an attempt to attract customers, members of the grocery store industry have employed a number of different promotions such as frequent shopper programs and weekly coupon specials. Despite these efforts, however, customer loyalty is no longer inherent due to the intense competition” (col 1, lines 25-45).

Hence, the prior art Walker (6,415,262) does disclose requiring or motivating or inciting a user/ customer to return to a retail business and helping to increase customer visits and loyalty to a retail business. Please read the prior art that was referenced and also the citations to which were referred.

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Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, in regards to Applicant's Arguments on page 5 that a 35 USC 103 rejection cannot be made after a 35 USC 102 rejection can be made, that is erroneous. A 35 USC 103 rejection can be made in a dependent claim after a 35 USC 102 rejection has been made on the independent claim. For example, the independent claim may state a 'vehicle'. However, the dependent claim may state, 'where the vehicle is an airplane'. A 102 rejection may be adequate for the independent claim stating a vehicle. However, a 103 rejection may be necessitated for the dependent claim stating 'where the vehicle is an airplane'.

Also, Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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- a) Solomon (6,847,935) discloses providing rebates and benefits;
- b) Walker (2002/0161670) discloses providing gift certificates and discounts.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
7/26/2006